

What Factors Should You Keep In Mind When Filing A Trademark Opposition In Myanmar?

Filing a trademark opposition offers a legal avenue to challenge applications that might infringe on your existing rights or compromise the integrity of the trademark system. Third parties have the right to oppose a trademark application if they believe it doesn't adhere to the criteria outlined in the Myanmar Trademark Law. KENFOX IP & Law Office will explore the crucial factors that need to be taken into account when filing a trademark opposition in Myanmar, encompassing the grounds for opposition, necessary documentation, deadlines, and the handling of objections by the Intellectual Property Department (IPD)

1. Grounds for a trademark objection or opposition

Section 26 of the Myanmar Trademark Law empowers any person to raise an objection against a trademark application if they believe it does not conform to the requirements outlined in Sections 13 and 14. Objections may be grounded on either absolute or relative grounds, or both.

Presently, the Myanmar Trademark Law does not explicitly delineate which parties possess the right to initiate opposition proceedings based on absolute grounds and/or relative grounds. Furthermore, the law does not impose any restrictions on the specific grounds upon which a party may base a trademark opposition. It is important to note that trademark practice in Myanmar is still undergoing development, and even examiners within the MIPD have limited experience with opposition cases

1.1. Absolute Grounds (Section 13)

Absolute grounds pertain to the inherent characteristics of the mark itself. Any third party may oppose a trademark application based on the following absolute grounds:

- (a) **Lack of Distinctiveness:** The mark is devoid of unique features that distinguish it from other marks.
 - (b) **Descriptive Marks:** The mark consists solely of indications or descriptions of the goods or services, such as their type, quality, quantity, intended purpose, value, geographical origin, time of production, or other attributes.
- However, these grounds do not apply if: **(i) Distinctiveness Through Prior Use:** The mark has acquired distinctiveness through extensive use before the application date, and **(ii) Exclusive Use in Myanmar:** The applicant has been using the mark exclusively and continuously in Myanmar's commercial sphere in good faith.
- (c) **Detrimental to Public Order, Reputation, Beliefs, or Traditions:** The mark is potentially harmful to public order, morality, reputation, beliefs, or traditions, including those of ethnic minorities.
 - (d) **Becoming Common Usage:** The mark has become commonplace in contemporary language or has become part of traditions and is used practically in the commercial sphere.
 - (e) **Misleading the Public:** The mark is likely to mislead or confuse the public, especially in relation to descriptive marks.
 - (f) **Unauthorized Use of Official Marks and Symbols:** The mark copies, imitates, or misleads without authorization by using all or part of a country's flag, emblem, or other official marks and symbols, or those of a state-authorized management or guarantee body, a quality guarantee mark, or a multilateral international organization.
 - (g) **Marks Protected under International Agreements:** The mark uses signs or symbols protected under international agreements to which Myanmar is a party.

2.2. Relative Grounds (Section 14)

Relative grounds concern the relationship between the mark and existing rights. Any third party can oppose a trademark based on the following relative grounds:

- (a) **Identical or Similar to Existing Marks:** The mark is identical or confusingly similar to a registered mark or a mark with an earlier application or priority claim for identical or similar goods or services.

- (b) **Unauthorized Use of Marks:** The mark uses, without consent, a mark that could harm the individual rights or reputation of a person or a legally formed organization.
- (c) **Infringement of Intellectual Property Rights:** The mark infringes on another person's intellectual property rights.
- (d) **Lack of Good Faith:** The mark application is made in bad faith, implying the applicant has no genuine intention to use the mark.
- (e) **Misleading Use of Well-Known Marks:** The mark is identical or similar to a well-known mark and is used for identical or similar goods or services, potentially causing confusion.
- (f) **Connection to Well-Known Marks:** The mark is identical or similar to a registered well-known mark, even if used for dissimilar goods or services, and suggests a connection with the well-known mark's owner, potentially harming their interests.

2. Required documents and information to file a trademark opposition in Myanmar

- **TM-8 Form:** Duly completed and executed by the Opposer.
- **TM-2 Form** (if applicable): Agent Appointment Form, appropriately notarized.
- **Trademark Application Number:** The specific application number against which the opposition is being filed.
- **Applicant's Name:** The full legal name of the trademark applicant.
- **Grounds for Opposition:** A clear and concise articulation of the specific legal grounds upon which the opposition is based, referencing the relevant provisions of the Trademark Law.
- **Class Number and Goods/Services:** The precise class number(s) and a detailed list of the goods or services within those classes that are being opposed.
- **Opposer's Information:** (i) Full legal name of the Opposer and (ii) Complete address and contact telephone number.
- **Representative's Information** (if applicable): (i) Full name and National Scrutiny Card number of the appointed representative and (ii) Business address and contact telephone number of the representative.

3. Drafting an opposition: Opposition Form and Fee

To initiate an opposition, the objector must complete and submit an objection form to the Registrar. The objection form serves as a formal and structured means to outline the grounds on which the objection is based. By providing specific details about the trademark application under consideration and the reasons why it fails to meet the required criteria, the objector builds a strong case against the registration.

Additionally, a prescribed fee must accompany the objection form. This fee covers the administrative costs associated with processing the opposition. It ensures that the Registrar can effectively manage the influx of objections and encourages objectors to thoroughly consider the validity of their opposition.

4. Deadlines

4.1. Deadline for filing a Notice of Opposition: A vital aspect of the opposition process in Myanmar is the strict time limit. Objectors have precisely 60 days from the date of the public announcement (as mentioned in Section 25(b)) to submit the objection form and the prescribed fee. This relatively short window serves as a critical opportunity for interested parties to carefully review the trademark application, conduct necessary research, and compile a well-founded objection.

4.2. Deadline for a counter-response: Upon receipt of the opposition notification from Myanmar IPD, the applicant needs to submit a counter-opinion and evidences for the trademark applicant within (60) days.

4.2. Appeal: Any person who is not satisfied with any opposition decision made under this Law by a Registrar may appeal to the Agency within 60 days from the date of announcement of this decision.

5. Handling of Trademark Objections and Oppositions

- **Notification and Examination:** Upon receipt of a timely and valid objection, the Registrar initiates the opposition process by notifying the applicant and requesting a counter-statement. This allows the applicant to respond to the objections raised and present their case for registration.

Subsequently, the Registrar conducts a comprehensive examination of the objections to determine their compliance with Sections 13 and 14 of the Trademark Law. This assessment involves a careful review of the objector's arguments, supporting evidence, and the relevant legal provisions governing trademark registration.

- **Decision and Notification:** Based on the examination findings, the Registrar has the authority to either allow or refuse the registration of the contested mark. If the objections are deemed valid and the application fails to meet the statutory requirements, the Registrar may refuse registration, thereby upholding the objector's interests and maintaining the integrity of the trademark system.

In contrast, if no valid objections are filed within the prescribed 60-day period, the Registrar may proceed to allow the registration of the mark. This signifies that the mark has successfully cleared the opposition stage and can move forward in the registration process.

- **Record-Keeping and Public Announcement:** Following the decision, the Registrar maintains a record of the allowance or refusal of registration and formally notifies the applicant of the outcome. Additionally, the Registrar is obligated to publicly announce the decision in accordance with the prescribed regulations, ensuring transparency and public awareness of the trademark registration process.

Final thoughts

Filing a trademark opposition in Myanmar is a crucial mechanism for protecting IP rights and ensuring the integrity of the trademark registration system. By diligently adhering to the provisions outlined in Sections 13 and 14 of the Myanmar Trademark Law, parties can effectively challenge trademark applications that may potentially infringe upon their rights or dilute their brand equity. The opposition process, administered by the Registrar, provides a transparent and impartial platform for evaluating objections, resulting in informed decisions that shape the trademark landscape in Myanmar.

At KENFOX IP & Law Office, we possess extensive experience in addressing the complexities of the opposition process. Our firm is dedicated to providing clients with comprehensive support and strategic guidance throughout the opposition proceedings, striving to achieve successful outcomes. As Myanmar's commercial environment continues to develop, proactively protecting your brand identity through trademark opposition is an essential component of a strong IP strategy.

**By Nguyen Vu QUAN
Partner & IP Attorney**

Contact

KENFOX IP & Law Office

Building No. 6, Lane 12/93, Chinh Kinh Street, Nhan Chinh Ward, Thanh Xuan District, Hanoi, Vietnam

Tel: +84 24 3724 5656

Email: info@kenfoxlaw.com / kenfox@kenfoxlaw.com